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TO: USPTO . 571-273-8300
MS Petition
Attn: Technology Center Director for Art Unit 3644

FROM: William E. McShane, Esquire

CLIENT/MATTER: 05500 - 00073 (Application Serial No. 10/690,411)

NO. OF PAGES: 5 (Including cover page)

DATE: October 26, 2005

COMMENTS:

Please deliver this paper to the
Technology Center Director for Art Unit 3644
(Ms. Teri Pham Luu)

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NO. 8494 P. 2

OCT 26 2005

Docket No.: 05500-00073-USC
PM00028-CON2 (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gary O. Maupin et al.

Conf. No.: 5949

Application No.: 10/690,411

Group Art Unit: 3644


Filed: October 21, 2003

Examiner: Smith, Kimberly S.

For: APPARATUS FOR APPLYING CHEMICALS
TO RODENTS

I hereby certify that this correspondence is being transmitted via telefacsimile to the U.S. Patent and Trademark Office at telefacsimile number
571-273-8300 on the date shown below.

Dated: 10/26/05

Signature: 
(William E. McShane)

PETITION TO WITHDRAW FINAL REJECTION PURSUANT TO 37 CFR 1.181

MS Petition
Attn: Technology Center Director for Art Unit 3644
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition to withdraw the Final Rejection in the above-identified patent application is being filed pursuant to 37 CFR §1.181 and MPEP §706.07(c) and §1002.02(c).

The Examiner issued a Final Rejection on July 5, 2005, finally rejecting all of the pending claims in the above-identified patent application. The two rejections contained in the Final Rejection were: (1) a rejection of claims 14 and 15 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement because the Examiner alleged that the specification provides no basis for the rodent being a mouse or the dimensions of the enclosure being of a size related to a mouse; and (2) a rejection of all pending claims (i.e., claims 1, 4 and 6-27) under 35 U.S.C. §102(b) based on an alleged public use or sale of the invention.

Both of the grounds of rejection in the Final Rejection were new in that they had not been made in the first Office Action on the merits. To justify the finality of the rejections the Examiner stated that applicant's Amendment necessitated the new ground(s) of rejection.

Application No.: 10/690,411

Docket No.: 05500-00073-USC

It is respectfully submitted that the Amendment referred to by the Examiner was applicant's Amendment filed on April 18, 2005. The amendments made to the claims in that Amendment narrowed the scope of those claims and the only new independent claim that was added (claim 12) was very similar in scope to some of the original claims that were pending at the time of the first Office Action. Two of the new claims were dependent claims 14 and 15, which further limited the "rodent" in each of the independent claims to a mouse. It is believed that this is the only amendment that the Examiner could be referring to as necessitating the new ground(s) of rejection, since the rejection under §102(b) based on new prior art was applied to all of the pending claims, including the claims that were substantially narrowed in the Amendment (this rejection is discussed in more detail below). However, as applicant advised the Examiner in their Response to Final Rejection dated September 6, 2005, the specification expressly discloses that the rodent can be a mouse and provides an example of an enclosure with dimensions that are clearly of a size related to a small rodent, such as a mouse. The Examiner has since withdrawn this rejection (see Advisory Action dated October 3, 2005). Thus, the only rejection that could possibly have been necessitated by applicant's Amendment was clearly erroneous and has been withdrawn.

With respect to the new rejection under §102(b), the Examiner cited a recent (May 2004) non-prior art publication to support an argument that the claimed invention was on public use or sale more than one year before the earliest filing date. However, this recent publication did not contain any new information that was not already cited in this application long before the issuance of the first Office Action on the merits. Specifically, the early field trials that were described in the recent publication cited by the Examiner were brought to the Examiner's attention in the Information Disclosure Statement filed on February 23, 2004 (see, for example, documents CA, CB, CL, CN and especially CO, which contains a detailed description of the Mason's Island field trial, including the important dates associated with that field trial). These publications contain far more information on the early field trials than the recent publication cited by the Examiner and were expressly considered by the Examiner in this application before the issuance of the first Office Action on the merits. If these field trials are relevant to the claims that existed after the Amendment referred to by the Examiner (and applicant does not agree that

Application No.: 10/690,411

Docket No.: 05500-00073-USC

they are), then they would be even more relevant to the broader claims that existed before the Amendment. Thus, it is simply impossible that the Amendment referred to by the Examiner could have necessitated the new grounds of rejection.

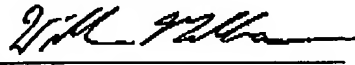
In view of the above explanation, it is respectfully submitted that the two new grounds of rejection contained in the Final Rejection dated July 5, 2005, were not necessitated by applicant's Amendment and should not have been made "final". Accordingly, it is respectfully requested that the Final Rejection be withdrawn as being premature.

Applicant wishes to point out that they already advised the Examiner in their Response to Final Rejection dated September 6, 2005, that they considered the "final" nature of the Final Rejection to be improper because the §112 rejection was clearly in error and the rejection under §102(b) could not have been necessitated by applicant's Amendment. Since the Examiner maintained the final rejection under §102(b) in the Advisory Action dated October 3, 2005, it is respectfully submitted that there should be no need for a further request for reconsideration of the final rejection to the Examiner.

It is believed that no fee is required with the present Petition. However, if any fee is due, the Director is hereby authorized to charge that fee to our Deposit Account No. 03-2775, under Order No. 05500-00073. A duplicate copy of this page is provided for that purpose.

Dated: October 26, 2005

Respectfully submitted,

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Application No.: 10/690,411

Docket No.: 05500-00073-USC

they are), then they would be even more relevant to the broader claims that existed before the Amendment. Thus, it is simply impossible that the Amendment referred to by the Examiner could have necessitated the new grounds of rejection.

In view of the above explanation, it is respectfully submitted that the two new grounds of rejection contained in the Final Rejection dated July 5, 2005, were not necessitated by applicant's Amendment and should not have been made "final". Accordingly, it is respectfully requested that the Final Rejection be withdrawn as being premature.

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